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EXAMINER

SAFAVI, MICHAEL

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,445

Applicant(s)

KARANIKAS, TERRY

Examiner

M. Safavi

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 21, 2005 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not appear to describe the limitation or condition of the "surfaces simultaneously provides *only horizontal supports* to a plurality of layers of discrete components". Such appears to be new matter. The specification does not appear clear and complete as to how the surfaces simultaneously provide *only horizontal support* to the discrete components.

The specification does not appear to describe the limitation or condition of “thereby forming at least one wall unit *having a substantially vertical surface* of said plurality of layers”. Such appears to be new matter. The specification does not appear clear and complete as to “forming at least one wall unit *having a substantially vertical surface* of said plurality of layers.”

The specification does not appear to describe the limitation or condition of “at least one of the... surfaces is characterized by curvilinear edges”. The specification does not appear clear and complete as to “at least one of the... surfaces is characterized by curvilinear edges”.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15, lines 8-9, it is not clear as to what is being defined by the recitation of “surfaces simultaneously provides *only horizontal supports* to a plurality of layers of discrete components”. The specification does not appear to clearly describe such a limitation or condition. It is otherwise, not clear as to how the surfaces simultaneously provide *only horizontal support* to the discrete components. Also, does “supports” define a singular element or plural elements?

Claim 15, lines 10-12, it is not clear as to what is being defined by the recitation of “thereby forming at least one wall unit *having a substantially vertical surface* of said plurality of layers”. The specification does not appear to clearly describe such a limitation or condition. It is otherwise, not clear as to how a wall unit is formed “*having a substantially vertical surface* of said plurality of layers.”

Claim 17, it is not clear as to what is being defined by the recitation of “at least one of the...surfaces is characterized by curvilinear edges”. The specification does not appear to clearly describe such a limitation or condition. It is otherwise, not clear as to how “at least one of the...surfaces is characterized by curvilinear edges”.

Further, it is not clear as to what is being set forth by claims 15-21 reciting “...[a] wall unit form and wall unit comprising...” Are claims 15-21 directed to a “wall unit form” or a “wall unit”?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Dial, Jr. '424. Examiner is treating "wall unit form" and "wall unit" as one and the same. Dial, Jr. teaches, Figs. 6, 8, 9, and 15-19, a wall unit form comprising a first panel, a second panel, and end wall panels 17, 17a operatively attached in an upright manner. Dial also teaches the capability of arranging at least one layer of discrete veneer components 64 adjacent one of the plurality of panels 66 (Fig. 15-16 and col. 8, lines 8-32). Pocket structures, or discrete components, 16, 16a are operatively attached to surfaces. A volume is formed which can produce an "integral footing". The limitations to "simultaneously provides only horizontal supports" as well as "thereby forming at least one wall unit having a substantially vertical surface of said plurality of layers" as well as "said entry being during placement of said discrete components" appear directed to intended use or environment or directed to process limitations. As such, no weight has been given to these limitations with respect to patentability.

Claims 15 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Carvel '504. Examiner is treating "wall unit form" and "wall unit" as one and the same. Carvel teaches, Figs. 26-33, a wall unit form 31 comprising first, second, and end surfaces operatively attached forming an upright form and opposing sides. The surfaces are hingedly attached (page 3, lines 58-62). Pocket structures, or discrete components, 8 are operatively attached to surfaces. A volume is formed which can produce an "integral footing". The limitations to "simultaneously provides only horizontal

supports” as well as “thereby forming at least one wall unit having a substantially vertical surface of said plurality of layers” as well as “said entry being during placement of said discrete components” appear directed to intended use or environment or directed to process limitations. As such, no weight has been given to these limitations with respect to patentability.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Dial, Jr. 424 or Carvel '504 in view of Schultz '761.

As stated above each of Dial and Carvel disclose forming a volume that can produce an “integral footing”. In any event, Schultz teaches, Figs. 2-5, forming a volume by providing extensions 9 on a mold to produce an “integral footing”; note that Schultz also teaches that the volume may have radiused corners as at 59 or 61. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the mold of Dial or Carvel to include extensions forming a volume, optionally including radiused corners, as taught by Schultz in order to provide integral forming of a footing. Note that this modification is consistent with Dial's disclosure that architectural details may be built into the blocks (e.g. note block 93 in

Fig. 14 and corresponding description in col. 7, lines 65-67) and Carvel's disclosure that the method may be employed to form wall sections of any desired shape such as may be designed by an architect for any particular part of the building (note page 3, lines 77-87).

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dial, Jr. '424 or Carvel '504 in view of Torricelli '570.

Dial only shows a rectangular wall unit and form. Carvel teaches a wall unit form based on rectangular aspects. Blocks having non-rectangular shapes, however, are notoriously old and well known in the art of building construction and wall units, the blocks formed as appropriate for the desired application and varied in shape to provide adaptability for constructions therewith. As merely an example, Torricelli teaches both a rectangular block (Figs. 1-4) and teaches a curved block (Fig. 12) to be a modification thereof. Accordingly, it would have been obvious and well within the skill of one with ordinary skill in the art at the time the invention was made to modify the wall unit form of Dial or Carvel to include a non-rectangular aspect or curved wall panel design(s) in order to enable creation of correspondingly shaped non-rectangular construction units since non-rectangular construction units were notoriously old and well known in the art, as exemplified by Torricelli.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-19 of U.S. Patent No. 6,629,395. Although the conflicting claims are not identical, they are not patentably distinct from each other because the added language to "provides only horizontal support..." or "thereby forming at least one wall unit having a substantially vertical surface of said plurality of layers of discrete components" or "said entry being during placement of said discrete components" does not add any structural feature over what is positively recited within claim 13 of U.S. Patent No. 6,629,395. In other words, it would have been obvious to one having ordinary skill in the art at the time the invention was made to create the form defined by U.S. Patent No. 6,629,395 for use in any specific molding technique or for forming any specific construction unit.

Response to Arguments

Applicant's arguments filed May 24, 2005 have been fully considered but they are not persuasive. Applicant appears to be arguing method with respect to "simultaneously

provides only horizontal supports" as well as "thereby forming at least one wall unit having a substantially vertical surface of said plurality of layers", (or, "the wall is formed in a vertical direction"), as well as "said entry being during placement of said discrete components". Such method limitation is not afforded weight in a claim to structure particularly with the applied prior art disclosing, alone or as modified, all the positively recited article of manufacture limitations of the rejected claims. Otherwise, Applicant may be arguing intended use or environment with respect to "simultaneously provides only horizontal supports" as well as "thereby forming at least one wall unit having a substantially vertical surface of said plurality of layers", (or, "the wall is formed in a vertical direction").

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (571) 272-7049. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 3673

M. Safavi
September 15, 2005